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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS H. GUERET

Appeal 2009-005633
Application 10/060,234
Technology Center 3700

Decided: January 7, 2010

Before WILLIAM F. PATE, III, MICHAEL W. O'NEILL, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jean-Louis H. Gueret (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1, 3-9, 11-17, 22-51, 60-67, 70-83, 85-91, 96-108, 110, 112-116, 118-121, 123, 132, 133, 135-141, 144-156, 158-164, 169-182, 184-192, 194, 203, 204, and 206-212. An oral

hearing was held on December 9, 2009. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

Appellant's claimed invention pertains to devices for applying a product, such as a cosmetic product, to a surface. Spec. 1, para. [001]. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A device for applying a product, the device comprising:

a first portion defining a recess;

a second portion moveable with respect to the first portion so as to selectively place the device in one of a closed position and an open position, wherein the first portion and the second portion define a substantially closed reservoir when the device is in the closed position; and

an application member attached to the second portion, the application member being at least partially compressible and configured such that, when the device is in the closed position, the application member is at least partially compressed inside the substantially closed reservoir and, when the device is moved from the closed position to the open position, the application member becomes substantially uncompressed,

wherein the application member is configured so that when the application member is uncompressed, the application member is capable of being loaded with substantially all of an amount of product that the device is capable of containing.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Hitchcock, Jr. (“Hitchcock”)	US 4,519,795	May 28, 1985
Gray	US 4,594,835	Jun. 17, 1986

Before us for review is the Examiner’s rejection of claims 1, 3-9, 11-17, 22-51, 60-67, 70-83, 85-91, 96-108, 110, 112-116, 118-121, 123, 132, 133, 135-141, 144-156, 158-164, 169-182, 184-192, 194, 203, 204, and 206-212 under 35 U.S.C. § 103(a) as being unpatentable over Gray and Hitchcock.

We note that the Examiner addresses dependent claims 43, 44, 115, 116, 187, and 188 (directed to multiple sachets removably joined together) separately from the other appealed claims. *See* Ans. 3, 4. Because all of the appealed claims stand rejected under the same statutory provision and over the same two references, and because Appellant argues all of the dependent claims as a group (App. Br. 19), we treat all of the appealed claims as subject to a single ground of rejection.

ISSUE

The Examiner found that Gray discloses all of the limitations of claim 1 except that Gray does not disclose the foam application member attached to the second portion. Ans. 3. The Examiner found that Hitchcock teaches an application device having a pad attached to a plastic strip, and the use of the strip as a handle. *Id.* at 3-4. The Examiner concluded that it would have been obvious to one of ordinary skill in the art, in view of Hitchcock’s teachings, to attach Gray’s foam application member to the top foil so as to

use the foil as a handle to apply a product without soiling one's hand. *See id.* at 4; Non-Final Rejection mailed Apr. 14, 2006, at 3. Appellant does not assert that any claim limitation is missing from the cited references.

Cf. App. Br. 14-15 (describing the teachings of Gray and Hitchcock).

Rather, Appellant contends that the Examiner's conclusion of obviousness is based on impermissible hindsight and is merely conclusory because there is no clear and particular suggestion or otherwise sufficient reason to combine the references. App. Br. 16. Appellant also contends that one would not be motivated to combine the references because the references teach away from making the proposed modification, and because the proposed modification of Gray would destroy the usefulness and function of Gray's V-notch (for opening the sachet). App. Br. 17-18. Therefore, the issues on appeal are:

Has Appellant shown that the Examiner erred because there is no rational reason why one of ordinary skill in the art would combine the references?

Has Appellant shown that the Examiner erred because the references teach away from making the proposed modification, and because the proposed modification would destroy the usefulness and function of Gray's V-notch?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Gray discloses a sachet for use in the medical field and which contains a product and a carrier, such as a sponge. Gray, col. 1, ll. 19-36. Gray discloses an embodiment where the top foil of the sachet is a laminate

of two films – a film of biaxially oriented polyethylene terephthalate and a film of low density polyethylene. *Id.*, col. 3, ll. 8-13. A V-notch 11 is provided near one end of the sachet to facilitate opening of the sachet. *Id.*, col. 3, ll. 22-23; fig. 1. Gray does not disclose attaching the carrier to any portion of the sachet.

2. Hitchcock discloses a disposable swab 10 for applying medicament to the skin. Hitchcock, col. 1, ll. 12-14. The swab comprises a flat sheet-like strip 12 and pad member 14 (which may be made from sponge material). *Id.*, col. 3, ll. 19-26; fig. 2. Hitchcock teaches affixing the pad member to the sheet-like strip and using the strip as a handle during the swabbing process. *Id.*, col. 3, ll. 22-43; fig. 3. Hitchcock explains that “the generally stiff strip may be made of a flexible plastic such as polyethylene, polypropylene, or the like.” *Id.*, col. 2, ll. 40-42. Hitchcock discloses another embodiment utilizing a “strip of semi-stiff polyethylene sheeting.” *Id.*, col. 4, ll. 6-8. A frangible pouch 32 is preferably heat sealed to the strip 12, thereby enclosing the pad member. *Id.*, col. 3, ll. 51-55; fig. 2. Hitchcock further discloses that a conventional tear tab 34 may be provided for easy removal of the frangible pouch 32 to expose the pad 14. *Id.*, col. 3, ll. 55-58. Hitchcock’s Figure 4 depicts a user peeling the pouch off of the strip. *Id.*, col. 3, ll. 9-11; fig. 4.

3. Hitchcock discloses that the pad member may be attached to the strip “by means of a conventional adhesive, a heat seal, or any other desired technique.” Hitchcock, col. 2, ll. 44-49. Thus, Hitchcock indicates that using the attachment technique is not beyond the skill of the ordinary artisan.

4. Hitchcock teaches that the disclosed swab also may be used for application of cosmetic ointments, make up, and hair dye, and may be used to apply touch-up stain to furniture. Hitchcock, col. 1, ll. 40-50.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103). “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Id.* at 417.

“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR Int’l Co.*, 550 U.S. at 416 (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966)). Whether a reference teaches away from a claimed invention is a question of fact. *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, ... would be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (quoting *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999)).

ANALYSIS

Appellant argues the rejected independent claims 1, 71, and 144 as a group. App. Br. 12, 18. We select claim 1 as the representative claim, and claims 71 and 144 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

Gray and Hitchcock are similar in that they both disclose an apparatus containing a product and an application member. Facts 1, 2. Gray's application member, e.g., a sponge, is not attached to either the top or bottom portion of the sachet. Fact 1. Hitchcock teaches the technique of attaching the applicator to one portion of the product container, such that the portion may be used as a handle to apply the product. Fact 2. Hitchcock also teaches that the applicator may be used to apply cosmetics, hair dye, and furniture stain. Fact 4. It would have been obvious to improve Gray's device by attaching the sponge to a portion of the sachet so that the portion may be used as a handle. Using the sachet portion as a handle would allow the user to apply a product without soiling his or her hands. It does not appear that utilizing the technique of attaching an applicator to a portion of the container would have been beyond the skill of the person having ordinary skill in the art. *See* Fact 3. Appellant has not persuaded us that the Examiner's conclusion of obviousness lacks a rational underpinning.

Appellant argues that there is no suggestion, motivation, or teaching to combine or modify the references. App. Br. 15-16. In particular, Appellant argues that the Examiner has failed to provide findings showing a "clear and particular suggestion" to combine the references. *See id.* at 15 (citations omitted). This argument is foreclosed by *KSR*, in which the Court rejected the rigid requirement of a teaching, suggestion or motivation to

combine known elements in order to show obviousness. *KSR Int'l Co.*, 550 U.S. at 418-19. The Court noted that an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. Further, the Examiner made findings regarding Hitchcock’s teachings, and points to those teachings as providing a motivation to modify Gray. *See* Ans. 3-4, 5. Therefore, we determine that the Examiner did not rely on impermissible hindsight, as Appellant urges (App. Br. 16), but rather relied on the knowledge of those skilled in the art at the time of the invention.

Appellant suggests that the Examiner’s position – that it would have been obvious to use the top foil as a handle to avoid soiling one’s hand – is an improper “obvious to try” rationale. App. Br. 16. However, a showing that the combination was obvious to try can support a conclusion of obviousness. *KSR Int'l Co.*, 550 U.S. at 421.

Appellant argues that Gray and Hitchcock teach away from modifying Gray by attaching the sponge to the top foil. App. Br. 17. Appellant’s argument is premised, in part, on the assertions that Hitchcock requires the handle strip to be “sufficiently stiff” and that Gray’s sachet material is unsuitable for use as a handle because it must be flexible and thin so that it can deform when a vacuum is applied during the manufacturing process. *Id.* While Hitchcock does refer to the use of a “generally stiff” sheet-like strip, Hitchcock also describes that same “generally stiff” strip as being made from “flexible plastic,” and discloses another embodiment utilizing “semi-stiff polyethylene sheeting.” Fact 2. Appellant does not direct us to any disclosure of Hitchcock that precludes the use of a thin, flexible strip or that

otherwise would discourage one of ordinary skill from applying the handle technique to Gray's device.

As to the argument that Gray's material is unsuitable for a handle, Appellant has not offered persuasive argument or evidence to rebut the Examiner's finding (Ans. 6) that Gray's top foil would be suitable as a handle for a sponge applicator. It seems that Gray's top foil, which is described as a two layer laminate (Fact 1), would be adequate to serve as a handle for a lightweight applicator such as a small sponge.

Appellant also asserts that the advantage of a mass production process "envisaged" by Gray (Gray, col. 2, ll. 24-35) – where the pockets are produced from two continuous webs of film or foil – teaches away from including any additional structure suitable for a handle. App. Br. 17. This argument does not show error in the rejection. First, as discussed above, Appellant has not persuaded us that Gray's foil requires additional structure to function as a handle. Second, Appellant does not explain why a flexible plastic strip, such as that taught by Hitchcock, could not be used in the manufacturing process mentioned in Gray. As such, Appellant has not persuaded us that Gray teaches away from attaching an applicator to the top portion of Gray's sachet.

Next, Appellant argues that one would not be motivated to attach a sponge to the top foil of Gray's sachet because doing so would destroy the usefulness and function of the V-notch. App. Br. 17-18. Appellant contends that the sachet opening created at the V-notch would be inadequate to remove a sponge attached to the top without further opening the sachet, e.g., separating the top and bottom foils from each other. App. Br. 18. While Appellant may be correct in that an additional step would be required to

open the modified sachet, we are not convinced the additional step would destroy the usefulness and function of the V-notch. Additionally, Appellant's scenario is similar to Hitchcock's description of preparing the swab for use by peeling the pouch off of the strip (Fact 2), thus further supporting the conclusion of obviousness. We also disagree with Appellant's apparent assertion (App. Br. 18) that tearing the sachet along the V-notch would affect the structural integrity of the foil such that it could not function as a handle. Even in Appellant's scenario, only the end of the top foil is removed, and the structural integrity of the remaining portion would not be adversely affected. Lastly, the Examiner reasonably concluded that it would have been obvious to one of ordinary skill to substitute another opening means for the V-notch. Ans. 6; *see also* Fact 2 (Hitchcock discloses the use of a conventional tear tab).

Appellant has not shown that the Examiner erred in rejecting independent claim 1 as unpatentable over Gray and Hitchcock. Accordingly, we sustain the rejection of claim 1, as well as the rejection of independent claims 71 and 144, which fall with claim 1.

Appellant does not present any additional arguments directed to the remaining claims on appeal, but merely asserts that the claims are patentable "by virtue of their dependencies from allowable independent claims 1, 71, and 144." App. Br. 19. Because Appellant has not shown that the Examiner erred in rejecting independent claims 1, 71, and 144 as unpatentable over Gray and Hitchcock, Appellant has also failed to show that the Examiner erred in rejecting the remaining claims over those references.

CONCLUSION

Appellant has not shown that the Examiner erred because there is no rational reason why one of ordinary skill in the art would combine the references.

Appellant also has not shown that the Examiner erred because the references teach away from making the proposed modification, or because the proposed modification would destroy the usefulness and function of Gray's V-notch.

DECISION

The decision of the Examiner to reject claims 1, 3-9, 11-17, 22-51, 60-67, 70-83, 85-91, 96-108, 110, 112-116, 118-121, 123, 132, 133, 135-141, 144-156, 158-164, 169-182, 184-192, 194, 203, 204, and 206-212 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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